

REMARKS

The new Claims 46 and 47 are computer-readable storage medium versions of Claims 1 and 24, respectively. The new claims do not present any new language, new limitation, or any new combination of limitations, that was not earlier examined. Further consideration is not required.

M.P.E.P. 714.16 states that amendments that add new claims after allowance should be accompanied by remarks that fully and clearly state the reasons on which reliance is placed to show: (1) why the amendment is needed; (2) why the proposed amended or new claims require no additional search; (3) why the claims are patentable; and (4) why they were not presented earlier. Accordingly, the following remarks are provided:

(1) Why the amendment is needed. Due to the nature of computer-implemented inventions (e.g. techniques that may be embodied in software), effective coverage requires claims that are directed to computer-readable media that contain instructions which, when executed, cause the inventive techniques to be performed. Without such coverage, it may be possible for competitors to flagrantly exploit the invention by selling software for performing the inventive techniques, while yet avoiding direct infringement of the method claims that cover execution of the techniques. Clearly, the value of a patent must be questioned if it allows competitors to practice the most likely form of exploitation without fear of direct infringement.

The new claims introduced by this amendment, therefore, are intended to provide direct protection against those who would otherwise be tempted to expropriate the invention by making, using, or selling computer readable media that contains software that performs the inventive techniques that are set forth in the method claims.

(2) Why the proposed amended or new claims require no additional search or examination. As mentioned previously, each of the proposed new claims mirrors a method claim that has already been examined and allowed. Thus, the new claims do not present any new limitation, or any new combination of limitations, that was not earlier examined.

(3) Why the claims are patentable. The new claims are patentable for exactly the same reasons that their corresponding method claims are patentable.

(4) Why they were not earlier presented. The claims were not earlier presented to avoid redundancy and wasted effort, both on behalf of the Examiner and on behalf of the Applicant. Specifically, the new claims contain no new limitations or no new combination of limitations. If the new claims had been earlier presented, then the Examiner would have had to determine the correlation between the method claims and computer-readable medium claims, and to apply to each computer-readable medium claim the same analysis that the Examiner applied to the corresponding method claim. Similarly, Applicant would have had to respond to each of the duplicated rejections. Further, any amendments would have to have been made identically to both sets of claims. The extra effort expended on duplicated rejections would have yielded no particular benefit to the examination of substantive issues.

For the foregoing reasons, entry and allowance of the amendments and additional claims presented by this amendment is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

If there are any questions, please call the undersigned at (408) 414-1201.

Respectfully submitted,

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